

Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

Page 2 of 6

Serial No.: 10/032,049

Confirmation No.: 5131

Filed: December 21, 2001

For: METHODS FOR PLANARIZATION OF METAL-CONTAINING SURFACES USING HALOGENS
AND HALIDE SALTS

Applicant's Claims 1-50

Applicant's claims 1-50 recite planarization methods including a planarization composition that includes a halogen-containing compound and a halide salt, wherein the halogen-containing compound and the halide salt *are separately delivered*.

Evans, on the other hand, neither discloses nor suggests a planarization composition including a halogen-containing compound and a halide salt that are separately delivered. Rather, as suggested by the Examiner in the Office Action mailed July 3, 2002 (e.g., page 3, lines 8-11), any halide salt that *may be present* is formed only as a result of the reaction of a halogen with a strongly basic aqueous solution (e.g., NaOH or KOH) to form (i.e., *in situ*) the halide salt.

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." M.P.E.P. §706.02(j). Evans discloses a planarization method including a composition that includes a halogen-containing compound. However, absent Applicants' disclosure, there is no disclosure or suggestion of a halogen-containing compound and a halide salt that *are separately delivered*.

The Examiner asserted that "it would have been obvious to one of ordinary skill in the art to combine (*sic*) the teaching of Evans as claims (*sic*), because the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results" (Office Action mailed December 11, 2002, page 3, lines 4-7, relying on *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946), EXHIBIT A, for support). The Examiner further asserted that "the transposition of process steps or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner and results, was held not to patentably distinguish the processes" (Office Action mailed December 11, 2002, page 3, lines 8-10, relying on *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959), EXHIBIT B).

Applicants respectfully disagree with the Examiner's assertions.

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For: METHODS FOR PLANARIZATION OF METAL-CONTAINING SURFACES USING HALOGENS
AND HALIDE SALTS

***EVANS FAILS TO DISCLOSE A HALOGEN-CONTAINING SALT AND A HALIDE SALT,
WHICH ARE SEPARATELY DELIVERED***

As described herein above, any halide salt that may be present in the compositions disclosed by Evans is formed only as a result of the *in situ* reaction of a halogen with a strongly basic aqueous solution. Thus, since any halide present must be *formed in the presence of the halogen*, Applicants respectfully submit that Evans fails to *enable* one skilled in the art to make and/or use compositions including a halogen-containing compound and a halide salt *that are separately delivered*.

***ONE CANNOT ARRIVE AT APPLICANT'S CLAIMED INVENTION BY CHANGING EVAN'S
SEQUENCE OF ADDING INGREDIENTS***

The Examiner urges that one of skill in the art may arrive at Applicant's claimed invention by modification of Evans through selection of the order of performing process steps, the transposition of process steps, or the splitting of one step into two. Although M.P.E.P. §2144.04(TV)(C) recites a case holding "*prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the *prior art process steps*" (*Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959), emphasis added), and further states that the "selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results" (*In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946)), these cases can be distinguished from the present rejection.

As discussed herein above, Evans lacks an enabling disclosure of compositions that include a halogen-containing compound and a halide salt *that are separately delivered*. Thus, one cannot arrive at Applicant's claimed invention by merely selecting the order of performing process steps, transposing process steps, or splitting one step into two. Notably, in *Ex parte Rubin* and *In re Burhans*, all the process steps were enabled in the prior art (i.e., prior art process steps). In contrast, Applicant respectfully submits that all the steps of the presently claimed invention (e.g., claims 1-50) are not enabled in the cited art.

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Thus, Applicant respectfully submits that the Examiner has not provided a convincing line of reasoning as to why one of skill in the art would be motivated to modify Evans to arrive at Applicant's claimed invention (e.g., claims 1-50).

Applicant's Claims 51-53

Applicant added new claims 51-53 in the Amendment and Response mailed October 30, 2002, and the Examiner responded by stating that "as discussed in the above claims, Evans discloses all the limitations in claims 51-53" (Office Action mailed December 11, 2002, page 3, last paragraph). Applicant respectfully disagrees, and submits that all the claim language of claims 51-53 has not been considered, and that convincing lines of reasoning for rejecting claims 51-53 are *not of record*.

For example, as described in detail herein below, claim 51 recites that the halogen-containing compound is selected from the group consisting of *ClBr, IBr, ICl, BrF, ClF, ClF₃, BrF₃, ClF₅, IF₃, IF₅, XeF₂, HgF₂, SF₆, alkyl halides, and complexes of X₂ with organic bases, and combinations thereof*; claim 52 recites a planarization method that includes a planarization composition, wherein the planarization composition includes a halide salt and a halogen-containing compound with *a halogen that is different than the halogen of the halide salt*; and claim 53 recites a planarization method that includes a planarization composition, wherein the *planarization composition is not basic*. Applicant respectfully submits that the Examiner has not placed on the record a convincing line of reasoning as to why the artisan would have found the invention (e.g., claims 51-53) to have been obvious in light of Evans. See M.P.E.P. §706.02(j). Applicant respectfully requests clarification of the Examiner's reasoning for this rejection in the next Official Communication.

Specifically, Applicant's claim 51 recites a planarization method including a planarization composition that includes a halogen-containing compound and a halide salt, wherein the halogen-containing compound and the halide salt are *separately delivered*. Applicant respectfully submits that claim 51 is patentable for at least the reasons recited herein

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above for the patentability of claims 1-50. Furthermore, claim 51 recites that the halogen-containing compound is selected from the group consisting of $ClBr$, IBr , ICl , BrF , ClF , ClF_3 , BrF_3 , ClF_5 , IF_5 , IF_7 , XeF_2 , HgF_2 , SF_6 , alkyl halides, and complexes of X_2 with organic bases, and combinations thereof. Conversely, Evans discloses planarization compositions that include elemental halogen, bromine (i.e., Br_2), iodine (i.e., I_2), or chlorine (i.e., Cl_2) (column 2, lines 31-34). Applicant respectfully submits that Evans fails to disclose or suggest any of the halogen-containing compounds recited in claim 51 of the present invention.

Claim 52 recites a planarization method that includes a planarization composition, wherein the planarization composition includes a halide salt and a halogen-containing compound with a halogen that is different than the halogen of the halide salt. Conversely, Evans discloses a slurry that includes a single halogen in the composition. Because any halide salt present would be formed *in situ* from the halogen or halogen-containing compound and the strongly basic solution, and there is no disclosure of using a combination of different halogen-containing compounds, Applicant respectfully submits that Evans neither discloses nor suggests a planarization composition including a halogen-containing compound and a halide salt wherein the halogen of the halogen-containing compound is different than the halogen of the halide salt, as recited in present claim 52.

Claim 53 recites a planarization method that includes a planarization composition, wherein the *planarization composition is not basic* (claim 53). Conversely, Evans discloses compositions in "a strongly basic aqueous solution" (e.g., claim 1 of Evans). Furthermore, non-basic planarization compositions are typically preferred to prevent damage to underlying substrate layers during planarization of the type that can occur with the use of basic compositions.

Applicant respectfully submits that the Examiner has not provided a convincing line of reasoning as to why one of skill in the art would be motivated to modify Evans to arrive at Applicant's claimed invention (e.g., claims 51-53).

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AND HALIDE SALTS**

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In view of the arguments presented herein, Applicant respectfully submits that the Examiner has failed to present a *prima facie* case of unpatentability for claims 1-53. Applicant respectfully requests that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103.

SUMMARY

It is respectfully submitted all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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February 11, 2003

Date

By:

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By:

Name: Jill R. Price

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Exhibit A

In re BURHANS

(CCPA)

69 USPQ 330

Decided Apr. 1, 1946

Appl. No. 5128

U.S. Court of Customs and Patent Appeals

Headnotes

PATENTS

1. Patentability--Aggregation or combination--In general

Contention, that references do not teach applicant's steps which are new in art and necessary to obtain desired result, has no merit in absence of proof in record that order of performing steps produces new and unexpected results.

Particular patents--Flour

Burhans, Enriched and Whole Wheat Flour and Bread, claims 2, 4, 5, 6, 8, and 10 of application refused.

Case History and Disposition:

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Appeal from Board of Appeals of the Patent Office.

Application for patent of Merton E. Burhans, Serial No. 401,968; Patent Office Division 63. From decision rejecting claims 2, 4, 5, 6, 8, and 10, applicant appeals. Affirmed.

Attorneys:

JOHN F. EAKINS, Chicago, Ill., for appellant.

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**W. W. COCHRAN (E. L. REYNOLDS of counsel) for the
Commissioner of Patents.**

Opinion Text

Opinion By:
O'CONNELL, Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the action of the Primary Examiner in rejecting in appellant's application for a patent claims 2 and 4 for a method of making flour, claims 5 and 6 for a method of making bread, and claims 8 and 10 for an article of manufacture of genuine whole wheat flour. The foregoing claims were all rejected as lacking invention over the prior art and claims 5 and 6 were further rejected as aggregative. There were no claims allowed.

Claims 4, 6, and 10 are illustrative and sufficiently descriptive of the alleged invention. They read:

4. The method of making genuine whole wheat flour which consists in separating the germs from the wheat, manufacturing flour from the remaining constituents of the wheat, aging the flour, incorporating therein finely divided non-rancid wheat germ constituents, and thereafter impregnating the flour with carbon dioxide.

6. The method of making genuine whole wheat bread which consists in separating germ constituents from wheat, reducing the remaining constituents of the wheat to flour, aging the flour, incorporating in the aged flour finely divided non-rancid wheat germ constituents, thereafter impregnating the flour with carbon dioxide, making the flour into dough and baking the dough while the flour still retains a substantial amount of carbon dioxide.

10. As an article of manufacture, genuine whole wheat flour comprising finely divided non-rancid wheat germ constituents and the remaining constituents of the wheat in finely divided and aged condition, the whole mass of the flour being impregnated with carbon dioxide.

The references are:

Currie (Br.) 5,614 of 1828

Byrne 29,859 Sept. 4, 1860

Dietz 1,974,808 Sept. 25, 1934

Donk et al. 2,085,421 June 29, 1937

Wellinghoff 2,230,417 Feb. 4, 1941

In support of his position here, appellant states in his brief:

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* * * It is pertinent to note that the reason that white bread is so widely used

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notwithstanding its well-known deficiencies, is that flour to be used by bakers must be aged before it acquires good baking qualities. The aging of flour is an oxidation process which can be effected by allowing the air to work on the flour for an adequate period of time. It was found that flour could be aged much more rapidly by incorporating therein an oxidizing agent and flour thus aged is usually referred to as "patent" flour. The wheat germ contains a large proportion of oil and this oil has a great tendency to become rancid. To avoid this rancidity the milling art has from time immemorial separated the germ from the wheat and the resulting flour could then be aged. The development of rancidity is also an oxidation process and if the germ were ground up with the wheat kernel the aging process would inevitably result in full development of rancidity.

The present applicant has discovered that carbon dioxide has the quality of preventing overaging of flour and of preventing the development of rancidity. Consequently his method of making a true whole wheat flour or an enriched flour comprises the following steps in the order stated:

- a. separating the germs from the wheat kernels and the manufacture of flour from the rest of the kernel;
- b. aging the germless flour;
- c. incorporating in the aged germless flour finely divided non-rancid wheat germ constituents; and
- d. impregnating the flour with carbon dioxide. (Emphasis quoted)

The appealed claims have all been rejected on Donk et al., Wellinghoff and Dietz in view of Byrne or Currie.

Currie shows a method of preserving grain and other vegetable and animal substances by the application of carbon dioxide while the material is stored in air-tight vessels, or other proper receptacles. He thus prevents, according to his disclosure, the tendency of the grain to vegetate and greatly hinders the decomposition of other vegetable and animal matters.

Byrne discloses a process for treating the flour of wheat and other grain with carbon dioxide while the flour is inclosed in an ordinary flour bolting chest. In his specification, Byrne states—

It is a well known fact to dealers in flour, that the flour of wheat when freshly ground is unfit for the use of bakers, as it makes a much smaller loaf than when it has acquired some age. It is also well known that too much age causes decomposition, the flour generates animalcules and becomes unfit for any use except starch manufacture. As a remedy for these evils, I treat freshly ground flour with carbonic acid gas. It renders fresh flour fit for immediate use and prevents flour at a far advanced age from decomposition.

In the patent to Dietz it is pointed out that "the introduction of the wheat germ, as such, into flour tends, by reason of the relatively large quantity of germ oil, to make the flour rancid and to affect its color and texture." Dietz describes a process for making flour by extracting the germ from the wheat, milling the residue into flour, extracting and activating the oil from the germ "to a high potency in vitamin D and the activated oil is then mixed with the residue of the germ in any desired proportion." The resultant mixture is then introduced in small quantities into flour prepared in any usual manner.

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Donk et al. relates to processes in treating wheat germ so as to make it useful in the manufacture of bakery and other food products. The patentee separately grinds and treats the fresh wheat germ as released in the flour mill in the process of milling. It is then packaged in appropriate containers in an inert gas such as carbon dioxide. Subsequently the treated wheat germ is incorporated into bakers' mixture. To cure the deficiency in refined wheat flour as ordinarily used for bread, one of the principal objects of Donk et al. is "to make available for introduction into the ordinary bakers' mixture for bread an even larger proportion of wheat germ than is ordinarily in the wheat grain or berry."

Wellinghoff removes the oil from the wheat germ and the non-rancid residue is reintroduced into the flour stream for further milling with the flour.

Dietz, Wellinghoff and Donk et al. do not specifically describe the step of aging the flour, but it is referred to in Byrne and each of the foregoing references contemplate that the flour would be aged prior to its use by the baker. The aging of flour is not only old in the art but it is also conventional as hereinbefore noted. In Dietz, Wellinghoff and Donk et al. the wheat germ is separately ground and treated to remove the rancid element in the germ and the non-rancid germ is thereafter incorporated in aged flour for the bakers' mixture. Donk et al. also shows that rancidity may be eliminated by storing the germ contents in carbon dioxide, and Byrne discloses

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that it is old to impregnate flour with carbon dioxide for the purpose not only of rendering freshly ground flour fit for immediate use by the baker but also of preserving the flour by the prevention of its decomposition.

The cited references considered collectively clearly suggest doing the thing that appellant has done in this case and the Primary Examiner and the Board of Appeals correctly decided that the methods and article defined in the appealed claims were not patentable over the art of record for the reason that what appellant has done would be obvious to anyone skilled in the art. See *In re Stover*, 32 C.C.P.A. (Patents) 823, 146 F.2d 299, 64 USPQ 186.

[1] Appellant contends that the references taken singly or together do not teach his characteristic four steps which are new in the art and which are necessary to obtain the desired result. There is no merit in the point here in the absence of any proof in the record that the order of performing the steps produces any new and unexpected results. See *In re Gibson*, 17 C.C.P.A. (Patents) 1090, 39 F.2d 975, 5 USPQ 230; *In re Lang et al.*, 25 C.C.P.A. (Patents) 1322, 97 F.2d 626, 38 USPQ 187; *In re McKee*, 23 C.C.P.A. (Patents) 1187, 83 F.2d 819, 29 USPQ 493.

In view of our conclusion it is unnecessary to discuss and pass upon the question of aggregation and the decision of the Board of Appeals is accordingly affirmed.

- End of Case -

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Exhibit B

Ex parte RUBIN**(BdPatApp&Int)****128 USPQ 440****Opinion dated Sept. 30, 1959****U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences**

Headnotes**FAX RECEIVED**

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PATENTS**1. Affidavits -- Anticipating references (§ 12.3)****Double patenting--In general (§ 33.1)**

If applicant's claims are rejected as not patentable over claims of his prior patent, a Rule 131 affidavit is ineffective, as only one patent can issue for a single inventive concept; if applicant's claims are patentably distinct over those of the patent, a Rule 131 affidavit would not be required; therefore, there is no need for Board to consider affidavit.

2. Abandonment--Disclosure without claiming (§ 10.7)

Basic requisite for rejection on ground that applicant dedicated claimed method to the public is that what is claimed in application is disclosed but not claimed in applicant's patent.

3. Patentability -- Change -- In general (§ 51.251)

Same product is obtained by either method claimed in application or that claimed in applicant's prior patent; no unexpected result is obtained by reversing order of steps recited in method claimed in patent; hence, method claimed in application is not patentable over patented method.

Particular patents--Coated Sheet

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Rubin, Method of Manufacturing a Conductive Coated Sheet, claims 2, 3, and 6 to 9 of application refused.

Case History and Disposition:

Appeal from Primary Examiner.

Application for patent, Serial No. 513,642. From decision rejecting claims 1 to 9, applicant appeals. Appeal dismissed as to claims 1, 4, and 5; affirmed as to claims 2, 3, and 6 to 9.

Attorneys:

EZEKIEL WOLF, Boston, Mass., for applicant.

Judge:

Before SURLE, Examiner in Chief, and MAGIL and WILES, Acting Examiners in Chief.

Opinion Text

Opinion By:

WILES, Acting Examiner in Chief.

This is an appeal from the final rejection of claims 1 to 9. Since claims 1, 4 and 5 were withdrawn from further consideration as not reading on the elected species, the appeal as to these claims will be dismissed, leaving for our consideration only claims 2, 3 and 6 to 9. No claims have been allowed.

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Claims 2 and 9 are sufficiently representative and are reproduced below:

2. A method of manufacturing a plate or sheet having an electrical conductive non-alkali metallic plated coating which comprises taking a base sheet of flexible impregnable paper material, first impregnating the sheet from at least one side with a thermosetting resin and partially curing said resin in the sheet, then depositing a smooth highly-conductive metallic film of uniform thickness on the other side capable of being etched into a printed circuit, and then laminating the sheet to a backing sheet of thermosetting material and making the final cure of the assembly under heat and pressure.

9. A method of manufacturing a plate or sheet having an electrical conductive nonalkali metallic plated coating including the steps of taking a base sheet of flexible impregnable paper material and first impregnating the sheet from one side with a thermosetting resin, and the additional steps of depositing a smooth metallic film of uniform thickness and capable of being etched into a

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printed circuit on the other side of the base sheet, and laminating the sheet with the metallic coating and the resin to a backing sheet of thermosetting material, with the backing sheet on the side of the base sheet opposite the metallic film.

The references relied upon are:

Backeland, 1,019,406, March 5, 1912.

Keller, 2,439,137, April 6, 1948.

Rubin, 2,680,699, June 8, 1954.

The claims are directed to a method of forming a laminated sheet, one surface of which is made of highly conductive material, which method is more fully described on pages 3 to 5 of appellant's brief.

The alleged invention of the instant application is best summarized by appellant on page 5 of his brief as relating "to a method of making a laminated sheet wherein a base sheet is *first impregnated* with a thermosetting material and thereafter *coated* with a metallic film."

The examiner has rejected the claims as unpatentable over Rubin as well as unpatentable over Keller in view of Backeland.

[1] As pointed out by appellant in his brief, the examiner several times seems to have considered appellant's patent as a publication, as he has rejected the appealed claims as unpatentable over the disclosure thereof, although in Paper No. 9, as well as in the statement, the rejection seems to be based upon the claims of the Rubin patent. The examiner has also expressed the view that a Rule 131 affidavit is ineffective for appellant to overcome his own patent if the present claims are unpatentable over the patent, and this view would imply, as more fully brought out by the examiner in answering appellant's arguments, that the basis for the rejection is the invention claimed in appellant's prior patent. In such a rejection if the appealed claims are not patentable over the claims of the patent, a Rule 131 affidavit obviously is ineffective, as only one patent can issue for a single inventive concept. However, if the claims herein are patentably distinct over those of the patent, a Rule 131 affidavit obviously would not be required. There is therefore no need to consider the Rule 131 affidavit.

[2] The examiner in his refusal of the claims has included in his statement language indicative that he considers appellant to have dedicated to the public the method recited in the appealed claims. A basic requisite for a rejection on this ground is that what is claimed herein is disclosed but not claimed in appellant's patent. However, the examiner has not even alleged that the sequence of steps required by the claims before us is disclosed in the patent, and we fail to find any such disclosure in the patent. In fact, the examiner's argument as to the non-criticality of the reversal of the order of steps of the present claims over those of the Rubin patent indicates the lack of any such unclaimed disclosure in the patent. It is obvious therefore that there is no basis for any "dedication" of the method claimed herein and hence the position of the examiner is untenable and cannot be sustained. Ex parte Harman, Patent File No. 2,520,280, 86 USPQ 487.

[3] This leaves for our consideration the question of whether the method claimed herein is patentable over the method claimed in appellant's patent as only one patent can be granted if there be but one invention. The examiner has quite fully set forth his position in support of this rejection and answered appellant's arguments with respect thereto. We therefore find little need for any extended comments except to note that

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appellant has not attempted to refute the examiner's position that it is not inventive to change the order of steps. In fact, appellant concedes that the same product is obtained by either the method claimed herein or that claimed in the patent. Moreover, appellant, on page 6 of the brief, states that:

"The method described in the patent is considered the better of the two

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methods invented, but the method set forth in the instant case does perform satisfactorily."

It is evident therefore that no unexpected result is obtained by reversing the order of steps recited in the method claimed in the Rubin patent. In re Haller et al., 24 CCPA 887, 1937 C.D. 281, 481 O.G. 6, 87 F.2d 520, 32 USPQ 306; New Wrinkle, Inc., et al. v. Watson, 1953 C.D. 18, 670 O.G. 306, 204 F.2d 35, 96 USPQ 436, 438. Accordingly, we agree with the examiner that the method recited in the appealed claims is not patentable over appellant's patented method and we will sustain the rejection.

The examiner has also rejected the claimed method as unpatentable over Keller in view of Baekeland, his position being as follows:

"Keller discloses impregnating a fibrous sheet with thermosetting resin and spraying a highly conductive metal on one or both sides of the sheet and laminating this to another similar resin impregnated sheet under heat and pressure. The Baekeland reference is used to show that curing a resin in several stages is old in the art. Partially curing the resin of Keller before the metal layer has been deposited is considered an obvious modification of Keller's process of curing. No invention is seen in applying a metal film of uniform thickness instead of the irregular thickness as in Keller since to do so would be mere mechanical expedient. Nowhere does applicant show the criticality of this step or that any new and unobvious result would be accomplished by coating the metal uniformly instead of non-uniformly."

While Keller discloses that the metal coating may be on one or both sides of the sheet, we find no disclosure therein which even suggests, when only one side is metallized, that the other side is to be impregnated with the thermosetting resin and that the impregnated side may then be laminated to a backing sheet of thermosetting material. Additionally, in the process of Keller it is the metallized face or side of the sheet which is laminated to a resinous material and results in a product which would not be suitable for appellant's purpose. We therefore are constrained to agree with appellant that the procedure of Keller is not suggestive of the claimed method and the rejection will not be sustained.

The appeal is dismissed as to claims 1, 4 and 5.

The decision of the examiner is affirmed.

- End of Case -

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PATENT

Docket No. 150.01180101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Brian A. Vaartstra)
Serial No.: 10/032,049)
Confirmation No.: 5131)
Filed: December 21, 2001)
For: METHODS FOR PLANARIZATION OF METAL-CONTAINING SURFACES
USING HALOGENS AND HALIDE SALTS

Group Art Unit: 2814
Examiner: T. Le

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